

### REMARKS

Claims 5, 6, 7, 9, 11, 20 and 21 are pending in this application. Reconsideration is requested based on the following remarks.

#### **Claim Rejections - 35 U.S.C. § 112:**

Claims 5, 6, 7, 9, 11, 20 and 21 were rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which is not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The rejection is traversed.

The Office Action asserts in section 4, in the last full paragraph at page 3, that:

The specification does not describe anywhere connecting the first event of the engineering activity to a set of second events of the engineering activity in a cause-and-effect relationship. The cause-and-effect relationship between the activities is not described anywhere in the specification. Therefore, claim 21 has no support in the specification.

Fig. 1, to the contrary, indicates that a predecessor (activity 101) leads to a successor (result 102), which one of skill in the art would understand to be a "cause-and-effect relationship." In particular, connections are shown being prepared to connect a first event of an engineering activity 101 to a set of second events of the engineering activity 101 in a cause-and-effect relationship in Figs. 1 and 2, and described at page 3, lines 13-19 and page 5, lines 22-29 of the English translation of the International Application PCT/DE00/00075, a copy of which was filed originally with the application.

Explicit support for claim language, moreover, is not required. It is well-settled, rather, that the test for compliance with the *description* requirement is whether a person skilled in the art would reasonably conclude from the disclosure whose filing date is being relied on that the inventor had possession, as of the filing date, of the claimed invention. See, e.g., *Vas-Cath, Inc. v. Mahurkar*, 935 F.2d 1555, 1563, 19 U.S.P.Q. 2d 1111, 1116 (Fed.Cir. 1991) and cases discussed therein. How the disclosure accomplishes this fact is unimportant. *Id.* The lack of literal basis in the specification for a negative limitation may be not be sufficient to establish a *prima facie* case for lack of descriptive support. *Ex parte Parks*, 30 U.S.P.Q. 2d 1234, 1236 (Board of Patent Appeals and Interferences 1993).

Claims 5, 6, 7, 9, 11, 20 and 21 are thus submitted to meet the requirements of 35 U.S.C.

§ 112, first paragraph. Withdrawal of the rejection of claims 5, 6, 7, 9, 11, 20 and 21 is earnestly solicited.

**Claim Interpretations:**

The Office Action asserts in section 5, in the last full paragraph at page 4, that:

Since the specification does not describe the cause-and-effect relationship, but describes the predecessor/successor relationship, the Examiner has interpreted the cause and-effect relationship to be same as the predecessor/successor relationship.

Fig. 1, to the contrary, indicates that a predecessor (activity 101) leads to a successor (result 102), which one of skill in the art would understand to be a "cause-and-effect relationship," as discussed above. Thus, the specification does describe a cause-and-effect relationship in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

**Claim Rejections - 35 U.S.C. § 102:**

Claims 5, 6, 7, 11 and 21 were rejected under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,303,170 to Valko et al. (hereinafter "Valko"). The rejection is traversed. Reconsideration is earnestly solicited.

The fifth clause of claim 21 recites:

Preparing first connections to connect the first event of the engineering activity to a set of second events of the engineering activity in a cause-and-effect relationship.

Valko neither teaches, discloses, nor suggests "preparing first connections to connect the first event of the engineering activity to a set of second events of the engineering activity in a cause-and-effect relationship," as recited in claim 21. Valko, rather, is determining the availability of alternative resources required before an activity can *commence*, not causes for the activity. In particular, as described in the Abstract:

For example, project/process simulation tool defines an activity; defines alternative resources required to commence the activity; determine availability of the alternative resources; and varies a duration of the activity based on the availability of the alternative resources.

Since Valko defines alternative resources required to commence an activity, Valko is not

"preparing first connections to connect the first event of the engineering activity to a set of second events of the engineering activity in a cause-and-effect relationship," as recited in claim 21.

In Valko, moreover, successors to starting an activity are signaled when a set of *prerequisites* necessary to start an activity are present. Prerequisites are not causes. There is no cause-and-effect relationship between the activity and the prerequisites to starting the activity, or between the successors to starting the activity and the activity. The activity, and the successors to starting the activity, rather, are going to start, they are just waiting to see when the prerequisites to starting the activity are present. In particular, as described in column 2, lines 43-64:

According to a third aspect there is provided a tool for computer modeling an activity within a network of activities, comprising: first determination means for determining when a first set of M prerequisites to starting the activity are present, said first determination means including means for selecting the set of from a set of N signals from a plurality of connected activities within the network wherein M is less than N but greater than 1; first signalling means, coupled to said first determination means, for signalling successors to starting of the activity when the first set of prerequisites are present; wait means, coupled to said first signalling means, for waiting for a duration of the activity responsive to signalling of the successors starting of the activity; second determination means, coupled to said wait means, for after said waiting, determining when a second set of prerequisites to finishing the activity are present; and, second signalling means, coupled to said second determination means for signalling successors to finishing of the activity when it has been determined that the prerequisites to finishing the activity are present.

Since, in Valko, successors to starting an activity are signaled when a set of prerequisites necessary to start an activity are present, Valko is not "preparing first connections to connect the first event of the engineering activity to a set of second events of the engineering activity in a cause-and-effect relationship," as recited in claim 21.

In Valko, moreover, each activity may have one or more signal lines 202A-H connecting it to other activities in the network or to itself in a *feedback* loop. Feedback is gathered *after* the activity takes place, and is thus not causation. In particular, as described in column 3, lines 43, 44, and 45:

Each activity may have one or more signal lines 202A-H connecting it to other activities in the network or to itself in a feedback loop.

Since, in Valko, each activity may have one or more signal lines 202A-H connecting it to other

activities in the network or to itself in a feedback loop, Valko is not "preparing first connections to connect the first event of the engineering activity to a set of second events of the engineering activity in a cause-and-effect relationship," as recited in claim 21.

In Valko, moreover, the model waits for signals from some number of *prerequisites* to start an activity. The activity is going to start, the model is just waiting to see when the prerequisites to starting the activity are present. In particular, as described in column 3, lines 43, 44, and 45:

In step 710 the model waits for signals from some number of prerequisites to start this activity, if any such prerequisites exist.

Since, in Valko, the model waits for signals from some number of prerequisites to start an activity, Valko is not "preparing first connections to connect the first event of the engineering activity to a set of second events of the engineering activity in a cause-and-effect relationship," as recited in claim 21.

The network shown in Fig. 1 of Valko, finally, is made up of a plurality of activities 102-112 selectively connected with one another by way of *signal* lines, not in a cause-and-effect relationship, contrary to the assertion in the Office Action at page 6. In particular, as described in column 2, lines 27-31:

An exemplary network of activities is illustrated in FIG. 1. The exemplary network is made up of a plurality of activities 102-112 selectively connected with one another by way of signal lines. A given activity can have a plurality of inputs and a plurality of outputs.

Since the network shown in Fig. 1 of Valko is made up of a plurality of activities 102-112 selectively connected with one another by way of signal lines, Valko is not "preparing first connections to connect the first event of the engineering activity to a set of second events of the engineering activity in a cause-and-effect relationship," as recited in claim 21. Claim 21 is submitted to be allowable. Withdrawal of the rejection of claim 21 is earnestly solicited.

Claims 5, 6, 7, and 11 depend from claim 21 and add further distinguishing elements. Claims 5, 6, 7, and 11 are thus also submitted to be allowable. Withdrawal of the rejection of claims 5, 6, 7, and 11 is also earnestly solicited.

**Claim Rejections – 35 U.S.C. § 103:**

Claims 9 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valko

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in view of U.S. Patent No. 6,278,977 to Agrawal et al. (hereinafter "Agrawal").

Claims 9 and 20 depend from claim 21 and add further distinguishing elements. Valko neither teaches, discloses, nor suggests "preparing first connections to connect the first event of the engineering activity to a set of second events of the engineering activity in a cause-and-effect relationship," as discussed above with respect to the rejection of claim 21. Agrawal does not either, as acknowledged graciously in section 4.1, at page 3 of the final Office Action mailed May 24, 2007. Agrawal, rather, starts with a set of unrelated activities, and discovers the real world relationships between them at a *later* point in time. Thus, even if Valko and Agrawal were combined, as proposed in the Office Action, the claimed invention would not result. Claims 9 and 20 are thus also submitted to be allowable. Withdrawal of the rejection of claims 9 and 20 is earnestly solicited.

#### Conclusion:

Accordingly, in view of the reasons given above, it is submitted that all of claims 5, 6, 7, 9, 11, 20 and 21 are allowable over the cited references. Allowance of all claims 5, 6, 7, 9, 11, 20 and 21 and of this entire application is therefore respectfully requested.

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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